The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte DAVID BAU III, ADAM BOSWORTH, GARY S. BURD
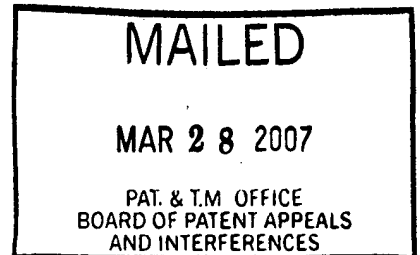RODERICK A. CHAVEZ, and KYLE W. MARVIN

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Appeal 2007-0435
Application 10/082,794
Technology Center 2100

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Decided: March 28, 2007

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Before KENNETH W. HAIRSTON, HOWARD B. BLANKENSHIP, and JEAN R. HOMERE, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1-52, the only claims pending in this application. We have jurisdiction under 35 U.S.C. §§ 6(b), 134(a).

INTRODUCTION

The claims are directed to the development of stateful Web services. Claim 1 is illustrative:

1. A method of specifying a stateful web service within a procedural programming environment, the method comprising:

providing a source code representation of at least a portion of web service logic,

the logic including one or more methods;

identifying one of said one or more methods to be exposed as part of the stateful web service; and

specifying one or more declarative annotations to cause a compiler to generate one or more persistent components to maintain conversational state related to the identified method.

The Examiner relies on the following prior art references to show unpatentability:

| Pagé | US 5,812,768 | Sep. 22, 1998 |
| Chan | US 6,230,160 B1 | May 8, 2001 |

BEA Weblogic Server 4.5 ("BEA"), *Using Weblogic Enterprise JavaBeans* (1999), available at http://www.weblogic.com/docs/cl...

Richard Monson-Haefel ("Monson-Haefel"), *Enterprise Java Beans*, 2nd Edition (2000), available at http://proquest.safaribooksonline.com/ 1565928695.

dreamBean Software ("dreamBean"), *EJBDoclet* (2000), available at http://sourceforge,net/projects/ejbodoclet/.

The rejections as presented by the Examiner are as follows:

1. Claims 1-52 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-22, 24-30, 33, 35-38, 41-63, 66-75, 77-80, 83, and 84 of copending Application No. 10/082,807.

2. Claims 1-4, 10-12, 15-17, 22-24, 26, 31, 32, 34, 36, 38, 39, 41, 44-46, and 48, are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8, 19-23, 26, 27, 31-36, 38, 39, 43, and 44 of copending Application No. 10/784,492.

3. Claims 1, 4, 10, 11, 16, 17, 22, 38, 39, and 44 are rejected under 35 U.S.C. § 102(b) as being anticipated by BEA.

4. Claims 2 and 3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over BEA and dreamBean.

5. Claims 5-8, 18, 23-25, 28-30, 40, 45-47, and 50-52 are rejected under 35 U.S.C. § 103(a) as being unpatentable over BEA and Monson-Haefel.

6. Claim 9, 19, and 41 are rejected under 35 U.S.C. § 103(a) as being unpatentable over BEA and Pagé.

7. Claims 12, 31, and 34 rejected under 35 U.S.C. § 103(a) as being unpatentable over BEA and Chan.

8. Claims 13, 20, and 42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over BEA and admitted prior art ("Background of the Invention" section appearing on pages 1-3 of the originally filed specification) ("APA").

9. Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over BEA, APA, and Pagé.

10. Claims 15, 21, 26, 27, 43, 48, and 49 are rejected under 35 U.S.C. § 103(a) as being unpatentable over BEA, APA, and Monson-Haefel.

11. Claims 32 and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over BEA, Chan, and dreamBean.

12. Claim 35 is rejected under 35 U.S.C. § 103(a) as being unpatentable over BEA, Chan, and APA.

13. Claim 36 is rejected under 35 U.S.C. § 103(a) as being unpatentable over BEA, Chan, APA, and Pagé.

14. Claim 37 is rejected under 35 U.S.C. § 103(a) as being unpatentable over BEA, Chan, APA, and Monson-Haefel.

OPINION

In the obviousness type double patenting rejection over Application No. 10/082,807, the Examiner compares instant claim 1 with claims 1 and 3 of the '807 application.[1] Appellants in response (Br. 6-7) submit that the claims of the '807 application are drawn to "an asynchronous web service" as recited in claim 1 of that application, and not to "a stateful web service as recited in claim 1 of the instant application." Appellants do not, however, provide any reasons why a "stateful" and an "asynchronous" web service should be regarded as patentably distinct.

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[1] According to the electronic image file wrapper of the '807 application, claim 3 was cancelled and the limitations of claim 3 were incorporated into base claim 1 by an amendment filed February 7, 2007. Current claim 1 in the '807 application is identical in substance to the claims of the '807 application evaluated in the Answer.

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The Examiner in response points out, *inter alia*, that claim 4 of the '807 application expressly claims "a stateful conversation between the client and the web service . . . ." (Answer 6-7.) Appellants in the Reply Brief (at 1) "continue to maintain that the rejection is improper" but offer to provide a terminal disclaimer "if the appeal process terminates with a holding that Appellants' claims are allowable in their current form." Appellants do not, however, offer any reasons in support of the belief that the rejection for double patenting is improper.

Because Appellants have not shown that the rejection is improper, we sustain the provisional rejection of the instant claims over the claims of copending Application No. 10/082,807.

In the obviousness type double patenting rejection over Application No. 10/784,492, the Examiner compares instant claim 1 with claims 1 and 3 of the '492 application. Appellants' remarks in the Reply Brief seem to acknowledge that the Brief's remarks about "domination" do not demonstrate error in the rejection for double patenting. Being not persuaded of error, we sustain the provisional rejection of the instant claims over the claims of copending Application No. 10/784,492.

In response to the rejections over the prior art, Appellants argue that instant claim 1 is not anticipated by BEA.

The minimum requirements of claim 1 are providing a source code representation, identifying a method, and specifying a declarative annotation. The claim is drawn to producing source code (i.e., producing a computer program listing) as depicted in instant Figure 2.

Appellants' arguments regarding the informational content of the source code are not persuasive. The product of the method is what has come

to be known as nonfunctional descriptive material, as discussed in *Manual of Patent Examining Procedure* (MPEP) § 2106.01 (8th Ed., Rev. 5, Aug. 2006).[2] Appellants also seem to rely on the intended use of what the source code may cause a compiler to do. The final step of claim 1, however, is "specifying" annotations. The claim is not limited to any compiler function; nor, for that matter, limited to any type of machine function.

The content of the nonfunctional descriptive material carries no weight in the analysis of patentability over the prior art. *Cf. In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004) ("'[w]here the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability,'" (quoting *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983)); *In re Lowry*, 32 F.3d 1579, 1583, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994) ("Lowry does not claim merely the information content of a memory. . . . [N]or does he seek to patent the content of information resident in a database.").

BEA is thus sufficient to show anticipation of the subject matter of instant claim 1. We sustain the § 102(b) rejection of claim 1.

Appellants rely on the arguments in support of claim 1 in response to the rejection of the remainder of the claims over the applied prior art.[3]

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[2] As explained in the referenced MPEP section, an invention directed to a mere program listing is nonstatutory. The Examiner should evaluate the claims under contemporary 35 U.S.C. § 101 Office guidelines in the event of further prosecution of claims similar to instant claim 1.

[3] Appellants repeat language of claim 16 (Br. 11), which is not an argument for separately patentability. *See* 37 C.F.R. § 41.37(c)(1)(vii) ("A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim."). Moreover, Appellants do

Appellants having not persuaded us of error in the rejection of any claim, we sustain all the rejections over the applied prior art.

CONCLUSION

In summary, the provisional rejection of claims 1-52 under the judicially created doctrine of obviousness-type double patenting over claims 1, 3-22, 24-30, 33, 35-38, 41-63, 66-75, 77-80, 83, and 84 of copending Application No. 10/082,807 is affirmed. The provisional rejection of claims 1-4, 10-12, 15-17, 22-24, 26, 31, 32, 34, 36, 38, 39, 41, 44-46, and 48 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8, 19-23, 26, 27, 31-36, 38, 39, 43, and 44 of copending Application No. 10/784,492 is affirmed. The rejection of claims 1, 4, 10, 11, 16, 17, 22, 38, 39, and 44 under 35 U.S.C. § 102(b) and the rejection of claims 2, 3, 5-9, 12-15, 18-21, 23-37, 40-43, and 45-52 under 35 U.S.C. § 103(a) are affirmed.

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not respond to the Examiner's findings in support of the rejection, much less demonstrate error in any of the findings.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR §1.136(a). *See* 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

PGC

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